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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/408,634 | 09/30/1999 | MARK WISNIEWSKI | AVERP2514USA | 4276 |

7590

06/15/2004

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| EXAMINER |
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HYLTON, ROBIN ANNETTE

| ART UNIT | PAPER NUMBER |
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3727

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/408,634
Filing Date: September 30, 1999
Appellant(s): WISNIEWSKI ET AL.

Heidi A Boehlefeld
For Appellant

EXAMINER'S ANSWER

MAILED
JUN 15 2004
GROUP 3700

This is in response to the appeal brief filed March 24, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 2,18,19,25,30, and 34 have been canceled.

This appeal involves claims 1,3-17,20-24,26-29,31-33, and 35-39.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Claims 1,3-17,20-24,26-29,31-33 and 35-39 have additionally be rejected under 35 USC 112, second paragraph.

(7) Grouping of Claims

Appellant's brief includes a statement that claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|---------------|--------|
| 4,915,289 | HATANO et al. | 4-1990 |
| 4,925,714 | FREEDMAN | 5-1990 |

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|-----------|--------------|--------|
| 5,637,366 | DAVIS et al. | 6-1997 |
|-----------|--------------|--------|

| | | |
|-----------|--------------|--------|
| 6,032,854 | GREER et al. | 3-2000 |
|-----------|--------------|--------|

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,3-14,23,29,32, and 32 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on October 21, 2003.

Claims 15-17,20-22,33, and 35-39 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on October 2, 2003.

Claims 24 and 26-28 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on October 21, 2003.

(11) Response to Argument

A. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the claims are directed to a closure comprising a first layer and a second layer with a peelable interface therebetween. There is no other structure set forth. The substrate of Freedman is capable of being a closure to the degree set forth in the claims since disclosed in the patent is a laminate comprising a first layer and a second layer with a peelable interface therebetween. Thus, the structure of Freedman is a closure and structurally meets the claims of the instant invention.

One of ordinary skill in the art desirous of providing a more easily separable interface and saving material would be motivated to utilize the teaching of bondable and non-bondable areas as found in the patent to Hatano. Additionally, Hatano teaches a non-bondable area at the interface of the closure and sealing flange for determining the direction of peeling during separation. This feature would not only enhance the separation of the first and second layers of Freedman, but would also guide the direction of separation.

Further, one of ordinary skill in the art knows uni-axially or bi-axially orientating film is well known for the intended use of the film as disclosed in column 1, line 42 of Davis. Thus, one of ordinary skill in the art would apply the teaching of uni-axially orienting the film for the desired benefit.

It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Appellant argues that the structure of Freedman could not be formed of other materials or alternative bonding materials cannot be used because the substrate is not specifically disclosed as being a closure as applicant intends the structure of the instant application to be. The intended use of the structure is not at issue.

Regarding the peel strength of the Freedman closure, the patent discloses the general conditions of the art. As set previously set forth, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Wherein a prima facie case of obviousness has been set forth, it is believed that the rejections should be sustained.

B. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where

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there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, applying the teachings of Freedman, Hatano, and Davis to the envelope of Greer would have been obvious to one of ordinary skill in the art as set forth in the rejection of the final Office action. Specific teaching of modifications found in the patents would result in an anticipation rejection under 35 USC 102. Motivation to make modifications to known structure is found in the knowledge which was within the level of ordinary skill at the time the claimed invention was made.

Wherein a prima facie case of obviousness has been set forth, it is believed that the rejections should be sustained.

C. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the non-bondable area is an edge portion of the laminate closure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Freedman does not teach a closure, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

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manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In this case, the claims are directed to a closure comprising a first layer and a second layer with a peelable interface therebetween. There is no other structure set forth. The substrate of Freedman is capable of being a closure to the degree set forth in the claims since disclosed in the patent is a laminate comprising a first layer and a second layer with a peelable interface therebetween. Thus, the structure of Freedman is a closure and structurally meets the claims of the instant invention.

Further, one of ordinary skill in the art knows uni-axially or bi-axially orientating film is well known for the intended use of the film as disclosed in column 1, line 42 of Davis. Thus, one of ordinary skill in the art would apply the teaching of uni-axially orienting the film for the desired benefit.

It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Appellant argues that the structure of Freedman could not utilized alternative bonding materials because the substrate is not specifically disclosed as being a closure as applicant intends the structure of the instant application to be. Again, the intended use of the structure is not at issue. Wherein a prima facie case of obviousness has been set forth, it is believed that the rejections should be sustained.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robin A. Hyton', written over the typed name.

Robin A. Hyton
June 13, 2004

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